

PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

10005747-1

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on December 6, 2005Signature Typed or printed name Alma Smalling

Application Number

09/981,166

Filed

October 16, 2001

First Named Inventor

Kent D. VINCENT

Art Unit

1773

Examiner

Sheeba AHMEN

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

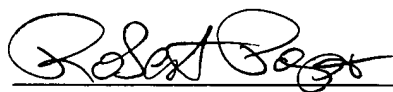
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Registration number _____

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Registration number if acting under 37 CFR 1.34 43,010

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December 6, 2005

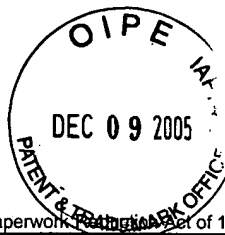
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NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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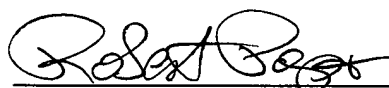
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U.S. Serial No. : 09/981,116 (Vincent et al.)
Conf. No.: 5610 Docket No.: 10005747-1
Attachment, Pre-Appeal Brief Request for Review, PTO/SB/33

A Final Office Action ("FOA") issued on 09/09/2005. All claims stand rejected. Each rejection is enumerated below, along with the appellant arguments as to why each rejection is defective. Each argument provides grounds as to why the Final Office Action should be withdrawn and allowance granted.

(1) Starting at page 3, para. 3, the Action rejects all pending claims as anticipated under Sec. 102 based on EP0427507A (Nicholas K. Sheridan), and in para. 4, under U.S. 5,389,945 (Nicholas K. Sheridan). Both cases are assigned to Xerox and referred to hereinafter as the "Xerox references." Appellant is informed and believes the EP case merely has a typographical error in the name. Both describe the same conventional state of the art type of printing and display technology-- known as "electronic ink" -- which is essentially based on the use of *hemispherically-distinctive microsphere elements*.

This electronic ink technology is directly distinguished by present applicants, Vincent et al., in the Background of the Invention section of the present application, and *in fact is shown specifically in Vincent et al. FIGS. 1BB and 1CC (Prior Art)*. This is not the technology of the present application.

The Vincent et al. application includes independent claims to a "...*bi-modal molecular colorant stratum...*" (Vincent et al. claim 1), wherein the "...*bi-modal molecular colorant stratum comprising: a molecular system, said system including electrochromic, switchable molecules, each of said molecules being selectively switchable between said at least two optically distinguishable states, wherein said system is distributable on the substrate thereby forming a display screen region.*" (Vincent et al., claim 4).

In addition to the many distinctions to electronic ink technology, the present technology (sometimes referred to in the art as "nanotechnology" - - no limitation on the scope of the invention is intended by the use of this term nor should any be implied therefrom) disclosed in the Vincent et al. application specification, drawings and claims, included and incorporated therein an extensive hard copy Appendix, which is a verbatim part of U.S. Pat No. 6,763,158,

having common inventorship and assignment to the present assignee. These materials and argument by the appellant - - including a detailed Color Switch Comparison Chart attached to the prior response exhibiting the numerous differences between the present invention technology and other known manners of technology in the state of the art - - submitted by appellant in an Amendment and Response (June 2005) to a prior Office Action (March 2005), describe a different from known manner electronic ink, and even possibly legally non-analogous.

The FOA sets forth only one general argument (para. 3 and para. 4) regarding all pending claims; namely, that there are "...elements being movable from a first orientation...first visual appearance, to a second orientation...second visual appearance...The spherical balls have at least two dissimilar surfaces of contrasting colors and differential surface charges." The Examiner admits "The spherical balls have at least two dissimilar surfaces of contrasting colors and differential surface charges." (para. 3) and "...the balls...rotate 180°...appear to be black. Conversely...rotate 180°...appear to be white." (para. 4).

The FOA fails to indicate how each and every claim, particularly how specifically claimed molecular-level elements, *supra*, can possibly be anticipated by the Xerox references' admittedly "microsphere technology." The simple answer is that there is no such disclosure in the Xerox references and therefore they can not serve as anticipatory prior art.¹

(2) The FOA also provides a brief Response to Arguments, starting at page 4, para.5, essentially making just one argument: "...that the claim limitations as discussed in the Detailed Description do not provide a definition or a description of what is meant by a "molecular color stratum" and hence the Examiner has interpreted such a phrase in its broadest possible meaning. In other words, the claimed invention as recited is not limited to a molecule or molecules designed to change in structural conformation when an electric field is applied."

¹ A valid rejection on the ground of anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. Soundsciber Corp. v. U.S., 148 USPQ 298, 301 (1966); In re Donohue, 226 USPQ 619, 621 (Fed. Cir. 1985). Emphasis added.

First, the allegation is newly raised. The inventors have not been given any opportunity to respond.

Second, the allegation is without basis. The term “molecular color stratum” is extensively defined and described. The Detailed Description at para. [0054] begins a detailed description of such “stratum 401” (precise antecedent basis term usage at page 33, line 7), which is clearly shown in Vincent et al.’s FIGS. 4AA, 4BB and 6AA. Moreover, the Appendix describes in extreme depth the nature of the individually switchable molecules used in the stratum 401 and how each and every molecule serves as a bi-modal, bi-chromic, switchable element. The claims are clearly distinguished from other state of the art modalities.

Third, it is not an Examiner’s duty to “interpret” claims or phrases in a vacuum.² The in depth description of the “nanotechnology” nature of the present invention in the specification and Appendix provide both the definition and description sought by the Examiner and a completely enabling disclosure for persons skilled in the art.

(3) The Examiner required Terminal Disclaimers to U.S. Pat. Nos. 6,731,532 and 6,809,956, by common inventors and assigned to the common assignee herein. The Examiner thus is aware that this application is one of a series of applications by the common inventors/assignee. The same Xerox references - - and other such microcapsule-type “electronic ink” references - - were not found to anticipate the common inventor/assignee’s U.S. Pat. Nos. 5,866,284 (Examiner Goodrow, J), 6,670,981 (Examiner Hai Pham), 6,806,453 (Examiner Yaritza, G) nor 6,850,230 (Examiner Eisen, A), all of which issued patents are in the series. Other issued patents in the series include U.S. Pat. Nos. 6,876,570, 6,853,577, 6,853,478, 6,822,893, 6,809,956, 6,731,532, 6,731,532, 6,579,742, and 6,556,470; each including the same Appendix and representing the related patentability of the respective inventions.

² Slimfold Mfg. Co. v. Kinkead Indus., 810 f.2d 1113, 1 USPQ 2d 1563 (Fed. Cir. 1987); Moleculon Res. Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986). The claim and specification language must be considered. DMI, Inc. v. Deere & Co., 755 F.2d 1570, 225 USPQ 236 (Fed. Cir. 1985)

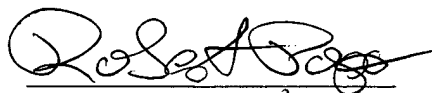
Applicants for patents must be afforded consistent prosecution by the U.S. Patent Office as a whole. If different standards or "interpretations" are put upon applicants, the reliability of the system is called into question. If individual Examiners are permitted to make arbitrary rules or judgements to conform patent applications to their individual preferences, the patenting system would decay into an unfathomable morass of peculiarities that no inventor could ever succeed in understanding or in complying with. It is no different from the doctrine of *stare decisis* which controls the lengths to which a court may go to render a decision or ruling if legal precedent has already been set in the past.

Conclusion

Appellant respectfully submits that the Final Office Action contains multiple clear errors in the Examiner's rejections and that the Examiner's rejections omits essential elements required to meet an adequate case for rejection under the law, the Regulations, and the MPEP. Applicant thus respectfully requests that the application be allowed on the existing claims and prosecution be closed.

Dated: 12.6.05

Respectfully submitted,



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